

Appl. No. 09/980,816
Amendment Dated December 8, 2003
Reply to Office Action of September 8, 2003

Attorney Docket No. 81833.0031
Customer No. 26021

REMARKS/ARGUMENTS:

Minor changes are made to this specification. Claims 1-3, 5, and 7-21 are canceled without prejudice. Claims 4 and 6 are amended. New claims 22-36 are added. Support for new claim 22 can be found on p. 9, lines 16-20 and on p. 17, lines 6-10 of the specification. Support for new claim 23 can be found on p. 9, lines 16-18 of the specification. Support for new claims 24 and 25 can be found on p. 9, lines 19-20 of the specification. Support for new claim 26 can be found on p. 9, lines 16-20 and on p. 17, lines 6-10 of the specification. Support for new claim 27 can be found on p. 9, lines 16-18 of the specification. Support for new claims 28 and 29 can be found on p. 9, lines 19-20 of the specification. Support for new claims 30-34 can be found on p. 17, lines 17-22 of the specification. Support for new claim 35 can be found on p. 17, line 23-p. 18, line 3 of the specification. Support for new claim 36 can be found on p. 20, lines 11-25 of the specification. Claims 4, 6, and 22-36 are pending in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

The present invention relates to a method and device for manufacturing a cosmetic sheet which enables a trial use of a powdery cosmetic such as a foundation, an eye shadow, a cheek color or the like hygienically as a sample, enables a sale thereof as a product and particularly enables a use thereof as a disposable product. (Applicant's specification, at p. 1, lines 6-12).

SPECIFICATION:

The specification stands objected to because the Office contends that at p. 1, line 21, the phrase "sampler is includes" should be changed to --sample includes--. In response, the Applicant changed the specification in the manner suggested by the Office. Withdrawal of this objection is thus respectfully requested.

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CLAIM REJECTIONS UNDER 35 U.S.C. § 112:

Claims 4, 6, and 16-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is moot with respect to claims 16-20 due to the cancellation of these claims. The Applicant respectfully traverses this rejection as to amended claims 4 and 6.

The Office states that claim 4 is incomplete. Specifically, the Office states, "The step of adhering lamination material to the upper surface of mount cannot be performed without first clearing and/or cleaning the upper surface from the cosmetic powder that covers the upper surface of mount by the filling step which fills the powdery cosmetic material on the upper surface of the mount." In response, the Applicant added the step of "clearing the upper surface of the mount of powdery cosmetic material."

The Office states, "Claim 4, lines 7-9: 'adhering lamination...mount and the pressed...adhering layer' is confusing." The Office recommends that either a comma or a semi-colon be inserted between "...the mount" and "and the pressed powdery..." In response, the Applicant inserted a comma between these two items.

The Office states, "Claim 4, line 10: cutting the mount to obtain a cut piece as a cosmetic material sheet is vague and indefinite for it is unclear as to formation of the cutting. The Office suggests that the phrase "cutting the mount between the plurality of concave portions to obtain a cut piece as a cosmetic material sheet" would provide a proper structural relationship between the claimed method steps. In response, the Applicant amended claim 4 to include the phrase "cutting the mount between or on the plurality of concave portions to obtain a cut piece as a

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cosmetic material sheet". Withdrawal of the rejection as to amended claim 4 is respectfully requested.

The Office states that claim 6 "appears to be incomplete for lacking an essential structural limitation of a means for cleaning the upper surface of the mount after the upper surface of the mount has been filled with powdery cosmetic material." In response, the Applicant added the limitation "a means for clearing the upper surface of the mount of powdery cosmetic material."

The Office states, "Claim 6, lines 7-8: 'a laminating device which adheres lamination material to the upper surface of the mount and the pressed powdery cosmetic material' is confusing for it is unclear whether or not the laminating device actually adheres the lamination material to the pressed cosmetic material." In response, the Applicant amended claim 6 to clarify that the lamination device adheres the lamination material to the upper surface of the mount and not the pressed powdery cosmetic material. Withdrawal of the rejection as to amended claim 6 is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102:

Claims 4 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Vaughn, U.S. Patent No. 2,365,920. Applicant respectfully traverses the rejection as to amended claim 4. Claim 4, as amended, is as follows:

A method for manufacturing a cosmetic material sheet comprising:

supplying a mount which has a plurality of concave portions formed on an upper surface of the mount;

filling powdery cosmetic material on the upper surface of the mount covering the plurality of concave portions;

pressing the filled powdery cosmetic material;

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clearing the upper surface of the mount of powdery cosmetic material;

adhering lamination material to the upper surface of the mount, and the pressed powdery cosmetic material forming a powdery cosmetic material adhering layer, wherein the uppermost lamination material is releasably adherent; and

cutting the mount between or on the plurality of concave portions to obtain a cut piece as a cosmetic material sheet.

Applicant respectfully submits that Vaughn cannot anticipate claim 4, because Vaughn fails to teach lamination material that is releasably adherent. Claim 4 was amended to clarify that the uppermost lamination material is releasably adherent. It is this feature of the present invention, which offers the consumer the benefit of being able to sample the cosmetic material prior to purchase. (Applicant's specification, at p. 3, line 16-p. 4, line 11).

In Vaughn, Figs. 16 and 17 show one of the temporary panels 80, which consists of a sheet 81 of cardboard, a sheet 82 of cotton velure or other suitable fabric marginally attached to the cardboard by staples 83, the pile of the cotton velure being towards the cardboard, and finally a coating 85 of sealing material on the exposed side of the cotton velure. (Vaughn, column 3, lines 52-59). Consequently, in Vaughn, the uppermost lamination material is attached by staples to the upper surface of the mount. Since staples are not releasably adherent, Vaughn does not allow the sampling benefits of the present invention.

In light of the foregoing, Applicant respectfully submits that Vaughn could not have anticipated or rendered obvious claim 4, because Vaughn fails to teach or suggest each and every claim limitation. Withdrawal of this rejection is thus respectfully requested.

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New claims 22-25 depend from claim 4 and cannot be anticipated or rendered obvious for at least the same reasons as claim 4.

Claim 6, as amended, is as follows:

A device for manufacturing a cosmetic material sheet comprising:

a supply device which supplies a mount which has a plurality of concave portions formed on an upper surface thereof;

a filling device which fills powdery cosmetic material on the upper surface of the mount wherein the powdery cosmetic material covers the concave portions;

a pressing device which presses the powdery cosmetic material;

a means for clearing the upper surface of the mount of powdery cosmetic material;

a laminating device which adheres lamination material to the upper surface of the mount, wherein the uppermost lamination material is releasably adherent; and

a cutting device which cuts the mount to obtain a cut piece as a cosmetic material sheet.

Claim 6, likewise, has the limitation "wherein the uppermost lamination material is releasably adherent." Consequently, claim 6 cannot be anticipated or made obvious for at least the same reasons as claim 4. Withdrawal of this rejection is thus respectfully requested.

New claims 26-34 depend from claim 6 and cannot be anticipated or rendered obvious for at least the same reasons as claim 6.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103:

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Claims 4, 6, and 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berman et al. (U.S. Patent No.5,953,885) in view of Gueret (U.S. Patent No. 4,962,627). This rejection is moot with respect to claims 17-20 due to the cancellation of these claims. The Applicant respectfully traverses this rejection as to amended claims 4 and 6.

Applicant respectfully submits that Berman and Gueret cannot render claim 4 obvious, because Berman and Gueret fail to teach or suggest a method for manufacturing a cosmetic material sheet comprising ... pressing the filled powdery cosmetic material. The Office acknowledges that Berman "lacks the specific teaching of the sample being cosmetic powdery material and the filled material being pressed by a pressing device." However, the Office maintains that "it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the method of Berman by having provided cosmetic powdery material and a pressing device for pressing the filled powdery cosmetic material, as taught by Gueret, in order to form a cosmetic sampler comprising powdery material in compact form."

In response, the Applicant respectfully submits that there is no motivation or suggestion to combine the teaching of Berman with the teaching of Gueret in the manner suggested by the Office. The Berman invention relates to a cosmetic sampler that incorporates the genuine cosmetic and a method of making a cosmetic sampler by application of a cosmetic to a substrate such as paper through the use of bulk thin film application techniques. (Berman, column 1, lines 6-10). In Berman, cosmetics are applied using a bulk thin film technique, i.e., non-printing technology such as by pulsed, metered on-demand spraying or extrusion, or continuous spraying, for example. This method enables economical mass production of cosmetic samplers of various configurations, including delivery of a sample on a carrier liner for inexpensive, fast dispensing and affixing. (Berman, column 2, lines

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21-27). Therefore, if Berman were to combine the pressing device for pressing the filled powdery cosmetic material as taught by Gueret, the principle of operation of the Berman would be destroyed.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP 2143.01

In light of the foregoing, Applicant respectfully submits that Berman and Gueret could not have made claim 4 obvious, because the combination of references fail to teach or suggest each and every claim limitation. Withdrawal of this rejection is thus respectfully requested.

Claim 6 is directed to device for manufacturing a cosmetic material sheet comprising ... a pressing device which presses the powdery cosmetic material. Consequently, claim 6 cannot be made obvious for the same reasons discussed above. Withdrawal of this rejection is thus respectfully requested.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Berman et al. (U.S. Patent No.5,953,885) in view of Gueret (U.S. Patent No. 4,962,627) as applied to claim 4 above and further in view of Misiano et al. (U.S. Patent No. 5,704,980). This rejection is moot due to the cancellation of this claim.

The art made of record but not relied upon by the Examiner has been considered. However, it is submitted that this art neither describes nor suggests the presently claimed invention.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los

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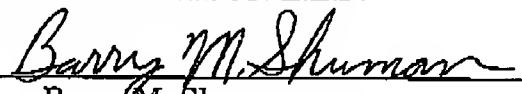
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Angeles, California telephone number (213) 337-6700 to discuss the steps necessary for placing the application in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

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